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BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD  
SEVENTH FLOOR  
LOS ANGELES, CA 90025-1030

EXAMINER

LAFORGIA, CHRISTIAN A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2131

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/820,110

Applicant(s)

RAMANATHAN, RAMANATHAN

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The amendment filed 09 June 2005 has been noted and made of record.
2. Claims 1-27 have been presented for examination.

***Response to Arguments***

3. Applicant's arguments filed 09 June 2005 have been fully considered but they are not persuasive.
4. In response to the Applicant's argument that the prior art does not teach the step of transmitting, by the second digital certificate authority, the twice-signed electronic document to the first digital certificate issuing authority and to the party, the Examiner respectfully disagrees. The Examiner acknowledges that the Applicant states on page 14 of the amendment filed on 09 June 2005 that the cited portion of the reference recites that the digital information may be transmitted to the customer. The disclosure that the information is sent to the party is enough to read upon the claim limitations, the fact that it may or may not occur is inconsequential. The Applicant is reminded that the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned, they are part of the literature of the prior art, relevant for all they contain. See MPEP 2123. See *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments. See *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998).

5. Therefore, the cited reference discloses transmitting, by the second digital certificate authority, the twice-signed electronic document to the first digital certificate issuing authority and to the party by disclosing that the possibility for it occurring exists.
6. See further rejections that follow.

*Claim Rejections*

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 1-4, 6-9, 11-14, and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,629,150 to Huded, hereinafter Huded.
9. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.
10. As per claims 1, 6, and 11, Huded teaches a method comprising:
- writing a party's authenticating information and a first digital certificate issuing authority's authenticating information in an electronic document (Figure 3 [block 322]; column 3, lines 15-24);
- signing, by the first digital certificate issuing authority, the electronic document to obtain a once signed electronic document (Figures 3 [block 321], 4 [block 321]; column 4, lines 7-45);

transmitting the once signed electronic document to a second digital certificate issuing authority (Figure 2; column 4, lines 46-59, column 6, lines 62-42, i.e. passing the once signed document from container 200 to container 150, transferring digital containers from Vendor A to Vendor B);

signing, by the second digital certificate issuing authority, the once signed electronic document to obtain a twice signed electronic document (Figures 5 [block 521], 6 [block 521]; column 4, lines 46-65); and

transmitting, by the second digital certificate issuing authority, the twice signed electronic document to the first digital certificate issuing authority and to the party (Figures 7, 8; column 4, lines 33-45, column 5, line 49 to column 6, line 7, i.e. transmitting to the original container and the client, or transmitting to the vendor who distribute to clients);

wherein the second digital certificate issuing authority is hierarchically superior to the first digital certificate issuing authority (column 6, lines 21-42, i.e. top level digital containers).

11. Regarding claims 2, 7, and 12, Huded discloses providing, as input to a hash algorithm, the contents of the electronic document (Figure 4 [blocks 230-232]; column 4, lines 7-17);

calculating, by the hash algorithm, a hash value (Figure 4 [blocks 311<sub>x</sub>, 400, 410]; column 4, lines 18-45);

encrypting the hash value using the first digital certificate issuing authority's private key (Figure 4 [blocks 420, 430]; column 4, lines 18-45); and

writing the encrypted hash value in the electronic document (Figure 4 [block 321]; column 4, lines 18-45).

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12. Regarding claims 3, 8, 13, 17, 19, and 21, Huded discloses writing the second digital certificate issuing authority's authenticating information in the once signed electronic document (Figure 5 [block 522]; column 3, lines 15-24, column 4, lines 46-65);

providing, as input to a hash algorithm, the contents of the electronic document (Figure 6 [block 200]; column 4, lines 46-59);

calculating, by the hash algorithm, a hash value (Figure 6 [blocks 500, 510]; column 4, lines 46-59);

encrypting the hash value using the second digital certificate issuing authority's private key (Figure 6 ["Signatory Key" and "DSA"]; column 4, lines 46-59); and

writing the encrypted hash value in the electronic document (Figure 6 [block 521]; column 4, lines 46-59).

13. With regards to claims 4, 9, and 14, Huded discloses wherein calculating the hash value comprises providing as input to the hash algorithm at least one of the party's authenticating information, the first digital certificate issuing authority's authenticating information, the digital signature of the first digital certificate issuing authority, or the second digital certificate issuing authority's authenticating information (Figure 4 [blocks 311<sub>x</sub>, 400, 410]; column 4, lines 18-45).

14. As per claims 16, 18, and 20, Huded teaches a method comprising:

receiving, from a first digital certificate issuing authority, a once signed electronic document at a second digital certificate issuing authority that is hierarchically superior to the first digital certificate issuing authority (Figure 2; column 4, lines 46-59, column 6, lines 21-42,

column 6, lines 62-42, i.e. passing the once signed document from container 200 to container 150, transferring digital containers from Vendor A to Vendor B);

writing the second digital certificate issuing authority's authenticating information in the once signed electronic document (Figures 5 [block 522]; column 3, lines 15-24, column 4, lines 46-65); and

signing, by the second digital certificate issuing authority, the once signed electronic document to form a twice signed electronic document (Figures 5 [block 521], 6 [block 521]; column 4, lines 46-65); and

transmitting, by the second digital certificate issuing authority, the twice signed electronic document to the first digital certificate issuing authority and to the party (Figures 7, 8; column 4, lines 33-45, column 5, line 49 to column 6, line 7, i.e. transmitting to the original container and the client, or transmitting to the vendor who distribute to clients).

15. Claims 5, 10, 15, and 22-27 are rejected under 35 U.S.C. 103(a) as being obvious over Huded in view of U.S. Patent No. 6,301,658 to Koehler, hereinafter Koehler.

16. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference

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under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

17. Regarding claims 5, 10, and 15, Huded teaches wherein writing a party's authenticating information and a first digital certificate issuing authority's authenticating information in an electronic document comprises receiving the party's authenticating information (Figure 1 [block 155], column 3, lines 42-51).

18. Huded does not disclose wherein said transmission is made via a secure connection.

19. Koehler discloses wherein said transmission is made via a secure connection (column 2, lines 28-34).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the transmission via a secure connection, since Koehler states at column 2, lines 28-34 that such a modification would serve to validate the authenticity of a client.

21. Regarding claims 22-27, Huded does not teach wherein the second digital certificate issuing authority is a root digital certificate issuing authority.



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22. Koehler discloses wherein the second digital certificate issuing authority is a root digital certificate issuing authority (column 3, lines 45-60).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the second digital certificate issuing authority as a root certificate issuing authority, since Koehler states at column 3, lines 45-60 that such a modification would establish authentication by verifying a hierarchical chain of digital signatures.

***Conclusion***

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

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27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian LaForgia  
Patent Examiner  
Art Unit 2131  
clf

  
Primary Examiner  
AU 2131  
3/17/05